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Serial No. 10/698,496
Attorney Docket No. 19799-206

REMARKS

Claims 14-24 are pending in this application. Claims 15 and 16 have been amended to correct their dependencies. New claims 26-29 are fully supported by Paragraph [0034] and do not constitute new matter.

Based on the arguments presented below, the various rejections should be withdrawn and the claims allowed.

I. Informality Objection

Claim 15 is objected to on the basis of an improper dependency on claim 13. Applicant has amended claim 15 to make it depend from claim 14.

II. Rejections under 35 U.S.C. 103(a) for Obviousness

The Examiner has rejected claims 14, 15 and 19-24 under 35 U.S.C. 103(a) as being unpatentable over Hutchins et al. (U.S. 6,676,659) and further in view of Richardson (U.S. Pub. No. 2003/0078473). Applicant traverses this rejection for the reasons presented below.

Claim 14 is the sole independent claim pending in this application. For the reasons detailed below, the Examiner has failed to make a *prima facie* showing of obviousness as to independent claim 14. On this basis, the rejection of claim 14, as well as dependent claims 15-24, should be withdrawn.

To establish a *prima facie* case of obviousness, the following three basic criteria must be met:

- (i) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
- (ii) there must be a reasonable expectation of success; and

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(iii) the prior art reference (or references when combined) must teach or suggest all the claim limitations.

MPEP Section 2143. Furthermore, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *Id.* (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

With respect to element (iii), the prior art references Hutchins et al. and Richardson fail to teach or suggest all the claim limitations. Neither Hutchins et al. nor Richardson teach or suggest a "tip diameter measuring less than approximately 0.063 inch." The 0.07 inch diameter of the distal portion in Hutchins et al. is greater than 0.063 inch; so by definition, it cannot be "less than approximately 0.063 inch." Richardson does not teach or suggest a "tip diameter measuring less than approximately 0.063 inch." Accordingly, the prior art references do not teach or suggest this claim element.

In addition, the prior art references do not teach or suggest a "taper length of approximately 3 millimeters or less." As the Examiner acknowledges, Hutchins does not teach or suggest a "taper length" at all. Richardson's distal taper "generally begins approximately 0.10 to 5.0 centimeters from the distal-most tip." See Paragraph [0038]. Thus, the distal taper of Richardson is not "3 millimeters or less." Furthermore, the incorporation of Richardson's distal taper into the device disclosed by Hutchins et al. does not teach or suggest a "taper length of approximately 3 millimeters or less."

With respect to element (i) of the *prima facie* case, there is no suggestion or motivation in the references to modify the reference or to combine reference teachings in the matter claimed by Applicant. None of the references recognize the navigation problem addressed by Applicant's invention and described, for example, in Paragraphs [0005] and [0012-0013] of Applicant's

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specification. Taper length is discussed in Richardson for a different purpose, namely controlling the amount of dilation of the opening (Paragraph [0039]).

Finally, the Examiner has failed to explain why there would be a reasonable expectation of success in the alleged modification or combination of the prior art references. Thus the Examiner has failed to establish the requirements for a *prima facie* case of obviousness with respect to Applicant's claims 14-24. Favorable consideration of the application is respectfully requested. If the Examiner has any questions, the Examiner is invited to contact Applicant's representative directly at (212) 969-3385.

Respectfully submitted,

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